

REMARKS

Claims 1-17 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

The applicants acknowledge and appreciate receiving an initialed copy of the form PTO-1449 submitted with the Information Disclosure Statement filed on September 30, 2003.

Claim 4 stands rejected under 35 USC 112, first paragraph, as being non-enabled. Without acknowledging the propriety of the rejection, the specification has been amended to address what is essentially a matter of clarity for which an objection would have been proper.

In order to establish a *prima facie* case of non-enablement the Examiner must show evidence that one of ordinary skill in the art would not have been able to practice the invention. As best understood, the Examiner is asserting that "how" the first frequency band is in a higher frequency side than a second frequency band is not described in the specification.

It should first be noted that a detailed explanation of "how" the invention works is not the test of enablement. It is well established that the applicants are not obliged to provide a detailed explanation of appurtenant features or provide a complete design specification. The specification need only describe the invention in such detail as to enable one of ordinary skill in the art to make and use the invention. Thus, a review of applicants' specification reveals that the first frequency band and the second frequency band are more than adequately described, for example, on page 16 lines 2 to 4, in a manner which would enable one of ordinary skill in the art to practice the claim as written. The specification however has been amended to clarify the relationship of claims 4 and 5 to the disclosed frequency bands, the disclosed band gap, and the first frequency band on a higher frequency side and the second frequency band on the lower

frequency side. Since claims 4 and 5 were part of the original disclosure it is submitted that no new matter has been entered.

It is respectfully submitted that the enabling disclosure of the subject matter associated with claim 4 is now clearly identified.

Claim 1 stands rejected under 35 USC 112, second paragraph, as being allegedly indefinite. The rejection is respectfully traversed.

Since the Examiner has admitted that the rejection is primarily made in view of issues of clarity, an objection would have been a proper way to address such issues. Applicants submit that claim 1 would have been understandable to one of ordinary skill in the art when read in light of the specification and no evidence has been provided to show otherwise.

A close review of Applicants' specification for example, at page 21 reveals that the term "first" and "second" are used interchangeably in the descriptions of various exemplary embodiments to describe various portions of the multiple-frequency common antenna. For example, on lines 13 and 15, helical antenna 32 is described as being used in accordance with different embodiments, as the "first" (line 15) in one embodiment, and the "second" antenna (line 13) in another embodiment.

Applicants are aware of no requirement that the term "first" and "second" when used in the claims must correspond to any use of the terms "first" and "second" which may appear in the specification. Neither are applicants aware of any overly limiting effect of the use of terms such as first and second in the claims in view of the specification. It is well established that the claim establishes the invention not the specification, and therefore a requirement to conform the claims arbitrarily to a description provided in the specification is legally unsound. It is commonly accepted that use of such terms as first and second can be reconciled within the claims

themselves as, for example, an initial reference to something in the case of “first” and a subsequent reference to another of the same thing in the case of “second”. Therefore a “first” antenna would simply correspond to the first recitation of an antenna and a “second” antenna would simply correspond to the second recitation of an antenna subject to the recitation of other features that might distinguish the first from the second.

It should be noted that the first antenna of claim 1 is recited as resonating in a first frequency band within a band gap provided on the surface of a substrate sheet while the second antenna of claim 1 is recited as resonating in a second frequency band out of the band gap. Thus, one of ordinary skill in the art when reading the claims in light of the specification would have understood *with a reasonable degree of certainty* that the first antenna of claim 1 is drawn to an antenna resonating in a first frequency band within a band gap provided on the surface of a substrate sheet, and would have understood that the second antenna of claim 1 is drawn to an antenna resonating in a second frequency band out of the band gap.

Since no evidence has been provided to show that one of ordinary skill in the art would not have been able to understand the claims *with a reasonable degree of certainty*, a *prima facie* case of indefiniteness has not been properly established. The rejection of claim 1, should therefore be withdrawn.

Claims 1, 3-6, and 9-12 stand rejected under 35 USC 103(a) as being allegedly unpatentable over Sievenpiper et al. U.S. Patent No. 6,433,756 (hereinafter “Seivenpiper”) in view of Tanaka Makoto JP 2003 304113. The rejection is respectfully traversed.

The applicants respectfully note that the Tanaka Makoto reference (JP ‘113) has a publication date of October 24, 2003 which is after the U.S. filing date of the present invention of September 30, 2003. Accordingly since JP ‘113 cannot properly be applied as prior art the

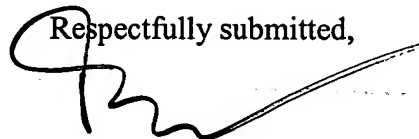
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applied art combination is improper. Accordingly the rejection of claims 1, 3-6, and 9-12 should be withdrawn.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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